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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,080	11/29/2000	Steven G. Himes	PM 268496	7496

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,080

Applicant(s)

HIMES, STEVEN G.

Examiner

Thomas A. Dixon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 0200 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims allowed are

Continuation of Disposition of Claims:

Claims pending are: 1, 15, 30-31, 45, 60-61, 75, 90, 101, 116, 120, 131, 136-139, 141-153, 155-162, 164-176, 178-185, 187-199, 201-204-208, 210-220, 222-245

Claims withdrawn are: 2-14, 16-29, 32-44, 46-59, 62-74, 76-89, 91-100, 102-115, 117-119, 121-130, 132-135, 140, 154, 177, 186, 200, 209, 221 and 463.

Claims allowed are: 31, 41, 60, 61, 75, 90, 116, 120, 131, 159-162, 164-176, 178-185, 187-199, 201-201, 2177-220, 222-240, 243-245

Claims rejected are: 1. 15. 30. 101. 136-139. 141-153. 155-158. 205-208. 210-216. 241-242

DETAILED ACTION

1 In response to applicant's assertion that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, though the features claimed have been overcome by a combination of references, the references all teach well known features of interfaces similar to applicant's invention and are combinable as indicated below.

2. A final review of the claims revealed claims rejections that had not properly been made.

Specifically, claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 1, 15, 30, and 101 are disclosed in Chapin Jr. in view of

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Yacoob, in view of Fulcher et al as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

3. The drawings are objected to by the draftsman, see drawing review 11/8/02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 15, 30, 101, 136-139, 141-146, 148-150, 152-153, 155-157, 205-208, 210-212, 214-216, 241-242 are rejected under 35 U.S.C. 103(a) as being anticipated by Chapin Jr. (5,931,878) in view of Yacoob (6,170,742) in view of Fulcher et al (6,505,774).

As per Claim 1, 15.

Chapin Jr. ('878) discloses:

entering means to enter supplemental data, see figure 1 (13);

transmitting means to transmit input data and supplemental data to a data management system, see column 2, lines 60-63;

selectively offering an incentive package, see figure 5 (44, 100, 106);

generating means to generate response data from the data management system, see figure 1 (16) and column 2, line 57;

displaying means to display data, see column 2, line 57;

updating means to update the input data based in part on the supplemental data and the response data, see column 3, lines 54-57;

storing means to store the updated input data, see column 3, line 25;

printing means to print the input data, supplemental data and response data, see column 3, line 60.

Chapin Jr does not disclose:

a reader capable of processing input and output from a smart card and

selecting means to select a language from a plurality of choices for use in any printed and displayed text .

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Yacoob ('742) teaches a reader capable of processing input and output from a smart card, see figure 4 (3003, 3004) for the benefit of customer convenience of not having to input data related to their personal or vehicle data.

Fulcher et al ('774) figure 11 (702) teaches a means for a user to select an alternate language, see column 18, lines 9-21, for customer retention and convenience of the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) in view of Yacoob ('742) to include the card reader and Fulcher et al ('774) for the language selection features for the benefit of customer retention and user convenience.

As per Claim 30, 101.

Chapin Jr. ('878) discloses:

a data entry station, see figure 1 (13);

a printer, communicating with the data entry station, , see column 3, line 60;

selectively providing a customer incentive package, , see figure 5 (44, 100, 106).

Chapin Jr ('878) does not disclose:

the use of smart cards;

selecting means to select a language from a plurality of choices for use in any printed and displayed text.

Yacoob ('742) further teaches:

1. a plurality of smart cards, see figure 4 (3004);

2. a smart card reader, see (3003);

3. a data entry station, communicating with the smart card reader, see (3000);

4. a printer, communicating with the data entry station, see figure 13 (789);

the communication link is wire and wireless communication, see figure 4 (3006) for the benefit of customer convenience of not having to input data related to their personal or vehicle data..

Fulcher et al ('774) figure 11 (702) teaches a means for a user to select an alternate language, see column 18, lines 9-21, for customer retention and convenience of the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to include the smart card use of Yacoob ('742) and the language selection features of Fulcher et al ('774) for the benefit of customer retention and user convenience.

As per Claim 136.

Chapin Jr. ('878) teaches the use of the internet, and portable devices are known to be used on the internet, but does not specifically teach a reader capable of processing input and output from a portable information storage device.

Yacoob ('742) further teaches the reader is capable of processing input and output from a portable information storage device, see figure 4 (3003) for the benefit of customer convenience.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to process user input or output from a portable device for the benefit of user convenience.

As per Claim 137.

Chapin Jr. ('878) further discloses the transmitting means is wire or wireless, see column 2, lines 60-63.

As per Claim 138.

Chapin Jr. ('878) further discloses the input data is maintenance schedule data, see column 3, lines 24-29.

As per Claim 141.

Chapin Jr. ('878) further discloses the data management system comprises a vehicle dealership management system, see figure 1.

As per Claim 145.

Chapin Jr. ('878) does not specifically disclose storing means is a portable storage device.

Yacoob ('742) further discloses the storing means is a portable storage device comprising a smart card, see figure 4 (3004) for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to store data on a portable device for the benefit of user convenience.

As per Claim 146.

Chapin Jr. ('878) further discloses the storing means is a dealer database system, see figure 1.

As per Claim 148.

Chapin Jr. ('878) further discloses a printing means to print the input data see column 3, line 60.

As per Claim 149.

Chapin Jr. ('878) teaches receiving supplemental data, stored data, data access, display and printing, but does not disclose smart cards.

Yacoob ('742) teaches:

a) the DMS and SCS are adapted to access data stored on the smart card and store accessed data in the DMS and print and display the accessed data, see column 6, lines 31-59 and column 20, lines 20-55;

b) the DMS and SCS are adapted to access data stored in the DMS and store the accessed data on the SCS and print and display the accessed data, see column 20, lines 20-55;

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c) the DMS and SCS are adapted to generate data in a user session and store the generated data in the DMS and SCS and to print and display the generated data, see column 20, lines 48-55; and

d) the SCS is adapted to receive input of supplemental data and store the inputted data in the DMS and SCS and to print and display the inputted data, see column 14, lines 38-42 and column 20, line 65 – column 21, line 26 for the benefit of user convenience of avoiding data reentry.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to store data on a portable device for the benefit of user convenience.

As per Claim 150, 205, 206.

Chapin Jr. ('878) further discloses the data entry station is a keyboard (figure 1 (12), but does not disclose a mouse and a touch screen.

Yacoob ('742) further discloses the data entry station is a keyboard with a mouse and a touch screen, see figure 13 (782) and column 14, lines 54-59 as well known combination of pc hardware for the benefit of user convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to use a well known combination of pc hardware.

As per Claim 152, 207.

Chapin Jr. ('878) further discloses the inputted data comprising customer information, vehicle information, maintenance schedule information, coupon information, see column 3, lines 24-60.

As per Claim 139, 153, 208.

Chapin Jr. ('878) further discloses contact information, see column 3, line 27.

As per Claim 142, 155, 210.

Chapin Jr. ('878) discloses the collection of telephone number, which in many systems known to be used as a personal identification number, but does not specifically disclose a personal identification number.

Yacoob ('742) further teaches the input data comprises a personal identification number, see figure 1 (1113) for the benefit of uniquely, anonymously identifying customers.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the system of Chapin Jr. to use an identification number as taught by Yacoob for the benefit of uniquely, anonymously identifying customers.

As per Claim 143, 156, 211, 213.

Chapin Jr. ('878) does not specifically disclose an administrator function.

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Yacoob ('742) further discloses the data input comprise administrator data that permit functions to be performed that are reserved for a system administrator, see figure 1 (1114) for the benefit of system security.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the system of Chapin Jr. to have administrator functions as taught by Yacoob for the benefit of system security.

As per Claim 144, 157, 212.

Chapin Jr. ('878) does not specifically disclose an access authorization.

Yacoob ('742) further discloses checking means to check access authorization of the input data from the user, see figure 5 (2001).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the system of Chapin Jr. to have administrator functions as taught by Yacoob for the benefit of system security.

As per Claim 214.

Chapin Jr. ('878) discloses storing and accessing information regarding vehicle dealership activities, see column 3, lines 49-55.

As per Claim 215.

Chapin Jr. ('878) discloses generating, storing and accessing information, but does not specifically disclose smart cards.

Yacoob ('742) further discloses generating, see column 20, lines 48-55, storing in a portable storage device comprising a smart card, see figure 4 (3004), and printing, see column 14, lines 38-42 and column 20, line 65 – column 21, line 26.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) in view of the smart card and security features of Yacoob ('742) for the benefit of customer retention, user convenience and data privacy.

As per Claim 216.

Chapin Jr. ('878) further discloses receiving and storing information to the SCS and to print and display the information, see column 3, lines 24-60.

As per Claim 241-242.

Chapin Jr. ('878) does not disclose the customer incentive package is at least in part parameterized.

Fulcher et al ('774) figure 11 (702) teaches the customer incentive package is at least in part parameterized, lower rates are offered based on longer parking terms or a coupon for future parking is dispensed based on the remaining time if more parking is paid for than is actually used, see column 17, lines 36-40 and column 18, lines 38-56, and a means for a user to select an alternate language, see column 18, lines 9-21, for customer retention and convenience of the user.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to include the parameterized incentive and language selection features of Fulcher et al ('774) for the benefit of customer retention and user convenience.

5 Claims 147, 151, 158, 213 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Chapin Jr. (5,931,878) in view of Yacoob (6,170,742) further in view of Fulcher et al (6,505,774) further in view of Filepp et al (5,347,632) or Collins-Rector et al (6,188,398).

As per Claim 147, 158, 213.

Chapin Jr. ('878) further discloses displaying means, see column 2, line 57..

Chapin Jr. ('878) does not specifically disclose displaying pop-up video clips.

Filepp et al ('632), see figure 3a (280) and Collins-Rector et al ('398) figure 2 (31, 33) teach displaying ads or video in order to create an enhanced advertisement experience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display pop-up video clips as taught by Filepp et al ('632) or Collins-Rector et al ('398) in the invention of Chapin Jr. ('878) to create an enhanced advertisement experience.

As per Claim 151.

Chapin Jr. ('878) further discloses a the data entry station is a keyboard, see figure 1 (12) and communications network (22), is the Internet, but does not disclose a mouse or touch screen.

Yacoob ('742) further discloses a mouse and a touch screen, see figure 13 (782) and column 14, lines 54-59 as well known combination of pc hardware for the benefit of user convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Chapin Jr. ('878) to use a well known combination of pc hardware.

Allowable Subject Matter

6. Claims 31, 45, 60, 61, 75, 90, 116, 120, 131 are allowable.

7. The following is an examiner's statement of reasons for allowance:

As per Claims 31, 60, 61, 116, 120.

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The prior art of record, specifically Chapin Jr. (5,931,878) in view of Yacoob (6,170,742) further in view of Fulcher et al (6,505,774) further in view of Filepp et al (5,347,632) or Collins-Rector et al (6,188,398), do not disclose or fairly teach:

providing a customer incentive package with selectively offered incentives, wherein the incentives are at least in part associated with prior a maintenance service performed on a vehicle by a vehicle service entity associated with the data management system and wherein the incentives are at least in part associated with recommended maintenance services to be performed on the vehicle by the service entity and wherein the incentives are selectively offered based at least in part on a maintenance schedule for a customer; and

As per Claims 45, 75, 90, 101, 131.

The prior art of record, specifically Chapin Jr. (5,931,878) in view of Yacoob (6,170,742) further in view of Fulcher et al (6,505,774) further in view of Filepp et al (5,347,632) or Collins-Rector et al (6,188,398), do not disclose or fairly teach:

providing a customer incentive package with selectively offered incentives, wherein the incentives are at least in part associated with prior a maintenance service performed on a vehicle by a vehicle service entity associated with the data management system and wherein the incentives are at least in part associated with recommended maintenance services to be performed on the vehicle by the service entity and wherein the incentives are selectively offered based at least in part on a maintenance schedule for a customer; and

the response data comprising recommended services, a savings amount during a visit and a total savings amount to date, based on the prior maintenance service.

The claims that depend from the above are allowed for the same reasons.

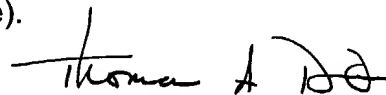
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3629